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| 10/043,009 | 01/08/2002 | Ralf Wolleschensky | GK-ZEI-3125 / 500343.201 | 6106 |
| 26418 | 7590 | 10/05/2006 | EXAMINER | |
| REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650 | | | EVANS, FANNIE L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2877 | |

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,009

Applicant(s)

WOLLESCHEFSKY ET AL.

Examiner

F. L. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 135-243 is/are pending in the application.
- 4a) Of the above claim(s) 227-243 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 135-226 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____


DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the invention of Group I, claims 135-226, in the reply filed on July 7, 2006 is acknowledged.

Claims 227-268 are withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to nonelected inventions.

The Specification

The substitute specification filed on April 25, 2002 contains obvious typographical errors. On pages 32, 33, 35 and 36 of the substitute specification, the symbol  (skull and crossbones) appears rather than the symbol ϕ . The error can be clearly seen on the noted pages and in paragraphs [0143], [0144], [0148] [0157] and [0159] of US 2003/0132394 A1, the published application. Correction is required.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 135-137, 139-145 and 147-196 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The invention set forth in method claims 135-137, 139-145 and 147-196 does not result in the transformation of an article or physical object nor does the invention provide a practical application that produces a useful, concrete and tangible result. Merely calculating (line 14 of independent claim 135),

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would not appear to be sufficient to constitute a tangible result, since the outcome of the calculating step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized. See, Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, 1300 OG 142, November 22, 2005. Attention is directed to section IV. of the guidelines, "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH THE SUBJECT MATTER ELIGIBILITY OF 35 U.S.C. SEC. 101." In part b. "Practical Application That Produces a Useful, Concrete, and Tangible Result" under section IV, the third sentence states 'In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible, and concrete."' "

The dependent claims do not appear to add any real world application required by the guidelines.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 135-226 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding line 6 of claim 135 and line 2 of claim 170, the words "particularly" and "preferably", respectively, render the claims indefinite because it is unclear whether the limitation(s) following the words are part of the claimed invention. See MPEP § 2173.05(d).

Regarding line 7 of claim 135; line 2 of claims 189, 190, 192, 193, 196 and 197; and line 3 of claims 195 and 197, the word "especially" renders the claims indefinite because it is unclear whether the limitation(s) following the word are part of the claimed invention. See MPEP § 2173.05(d).

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The extensive use of "and/or" in lines 7 and 8 of independent claim 135 and in lines 3 and 4 of independent claim 197 renders the claims indefinite as to the type of light being detected.

The lack of an antecedent basis for "the scanned line patterns and/or point patterns" in line 2 of claim 203 renders the claim or any claim dependent therefrom indefinite.

Correction is required.

Prior Art

Cole et al (Journal of Microscopy) disclose time-domain whole-field lifetime imaging using optical sectioning.

Allowable Subject Matter

Claims 138 and 146 would be allowable if rewritten in independent form to overcome the rejection(s) under 35 U.S.C. § 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 197-226 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, 2nd paragraph, set forth in this Office action.

Claims 135-137, 139-145 and 147-196 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 101 and 35 U.S.C. § 112 set forth above in this Office action.

As to independent claim 135, the prior art of record, taken alone or in combination, fails to disclose or render a method for depth-resolved optical detection of a specimen comprising the steps carrying out the scanning movement and detection associated with the scanning movement at least in a first and a second different phase position of the modulation and/or first and second frequency of the periodicity of the modulation and calculating at least one optical section image through the specimen or through part of the specimen, in combination with the rest of the limitations of the claim.

As to independent claim 197, the prior art of record, taken alone or in combination, fails to disclose or render obvious an arrangement for depth-resolved optical detection of a specimen comprising

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means for generating a relative movement between the specimen and illumination light and means for calculating at least one optical section image from the local information of the light influenced by the specimen, in combination with the rest of the limitations of the claim.

Fax/Telephone Numbers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext 77. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


F. L. EVANS
PRIMARY EXAMINER
ART UNIT 2877

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September 28, 2006